

REMARKS

This responds to the Office Action mailed on December 19, 2005.

Claim 22 is amended and claims 36-40 are added; as a result, claims 22-25 and 32-40 are pending in this application.

Support for claims 36, 37, 38, 39 and 40 can at least be found in the present application at page 5, lines 1-2; page 6, lines 17-18; page 5, line 5; page 5, lines 8-9; and page 5, lines 15-16, respectively.

§102 Rejection of the Claims

Claims 22-25 and 32-35 were rejected under 35 USC § 102(b) as being anticipated by Rondeau (U.S. 5,850,433).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.¹ It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.”²

The Office Action states that the prior art structure is capable of performing the intended use, apparently relying on a theory of inherency. Applicant respectfully disagrees and points out that in order to rely upon a theory of inherency which would support the assertion that Rondeau *is capable of* performing the intended use, the Office Action must provide a basis in fact and/or technical reasoning to support that such characteristic *necessarily* flows from the teachings of Rondeau.³

Applicant respectfully submits that the Office Action did not make out a *prima facie* case as Rondeau does not teach each and every claim element.

¹ *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

² *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

³ See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

With respect to presently amended claim 22, Applicant submits that Rondeau does not disclose “a second electronic device coupled to the registry server across a network” as disclosed in claim 22. Additionally, Applicant submits that the server 28 in Rondeau is coupled to the database 14, and Applicant fails to find in Rondeau any server, where the “server compris[es] a registry server,” as is recited in Claim 22. In contrast, it appears to the Applicant that Rondeau shows one or more databases 14 coupled to the database server 28.⁴

Additionally, it is clear from the specification of Rondeau that the server 28 in Rondeau responds *completely* to the request for information.⁵ Applicant fails to find in Rondeau any mention that the server 28 is capable of responding only partially to a service request. In particular, the server 28 in Rondeau receives a request for a directory listing and responds *totally* to the request by returning the directory listing.⁶ Rondeau is unable to respond partially to any request.

With respect to claim 32, Applicant submits that the network adapter 32 relied upon in the Office Action is not a network adapter as contemplated in claim 32. The network adapter 32 in Rondeau is in actuality a Local Area Network.⁷

With respect to the claims that depend from the above mentioned independent claims, Applicant respectfully submits that a dependent claim incorporates each of the claim elements of the independent claim from which it depends, so that the dependent claims are patentable over the reference applied in the office action for at least the same reasons that apply to those claims.

Applicant respectfully submits that claims 22-25 and 32-35 are allowable over Rondeau for at least the reasons stated above and requests withdrawal of the 102(b) rejection and allowance of the claims.

With respect to newly added claims 36-40, which properly depend from independent claim 22 and incorporate all the elements of claim 22, Applicant respectfully submits that claims

⁴ See Rondeau, Col. 6, Lines 14-28.

⁵ See Ronedau, Abstract.

⁶ See Rondeau, Col. 1, Lines 1-24.

⁷ “interconnected with one another over a local area network (LAN) 32. Rondeau, Col. 5, Lines 17-18.

36-40 are allowable for at least the reasons stated above. Additionally, Applicant fails to find in Rondeau where the “registry server is implemented in [XML]” as recited in claim 36, “the service request is an XML formatted message” as recited in claim 37, “the registry server is implemented in [EDI]” as recited in claim 38, “the service request includes a header, the header including an address of the first electronic device, and the service requested” as recited in claim 39, or “the second electronic device is to respond to the service request received from the first electronic device, the response to include a response to the first electronic device and a request to the third electronic device” as recited in claim 40. Applicant respectfully submits that newly added claims 36-40 are allowable over Rondeau for at least these reasons.

Applicant's Responses of 9/16/2005 and 2/21/06

Applicant directs attention to the previously filed responses. Applicant respectfully renews those reasons for allowance over Rondeau, but in the interests of brevity in the instant response, chooses not to copy the text here.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 10/027,440

Filing Date: December 20, 2001

Title: ALGORITHM FOR WEB SERVICES FULFILLMENT IN A PEER-TO-PEER ENVIRONMENT

Assignee: Intel Corporation

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Dkt: 884.623US1 (INTEL)

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-371-2159 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

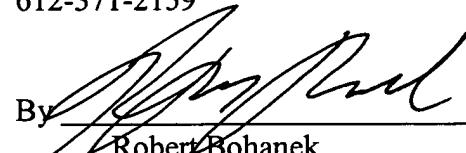
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of March, 2006.

Name

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Signature

